

Appl. No. : 10/065,120
Filed : September 18, 2002

REMARKS

Reconsideration and allowance of the above-referenced application is respectfully requested.

Initially, the Examiner is thanked for conducting the interview on July 13, 2004. During that interview, the differences between what the undersigned believes to constitute the "invention" and the cited prior art were discussed. Many of these comments are summarized herein.

Claims 1-50 are pending with claims 37-50 as "withdrawn from consideration". However, the Patent Office is authorized to cancel the non-elected claims via Examiner's amendment when the case is otherwise ready for issue; MPEP 821.02.

All of the rejections previously presented in the case had been withdrawn except for the rejection of claims 1-35 as allegedly being unpatentable over Seiple in view of Ohyama. Claims 1-35 stand rejected under 35 U.S.C. 103 as allegedly being unpatentable over Seiple in view of Ohyama. This contention is respectfully traversed.

The rejection reasons that Seiple teaches the claimed method for operating a position detection module, and that Ohyama teaches a manual switch to place an apparatus in "sleep" mode. However, it is respectfully suggested that:

- 1) If Seiple were modified by the teaching in Ohyama, it would destroy the intended functionality of Seiple, and
- 2) The two references are from such different fields of art, that it would not be obvious for one having ordinary skill in the art to make the kind of combination postulated by the rejection, and

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3) Even if the hypothetical combination were made as suggested, that it would still not teach or suggest the features of the currently rejected claims.

Moreover, during the interview, the Examiner explained his interpretation of certain references noted below, and those interpretations are included. In order to further distinguish over each of the references cited in the Official Action, amendments are made to these claims such that each claim recites operation of a cellular phone (not suggested by either Seiple or Ohyama), and such that the claims state that the actuation that turns off the position privacy module is made to enhance privacy (again, not suggested by Seiple or Ohyama). Finally, the point is re-made herein – that even if Seiple could have certain data stored therein, his teaching is that GPS should NOT be completely turned off, as currently claimed.

1. Modification Of Seiple By The Teaching In Ohyama Would Destroy The Inherent Functionality Of Seiple.

Claim 1 specifies an electronic device with a position detection module, and an override control which "prevents said position detection module from determining its position, but which allows other parts of said electronic device to operate". Other claims define this in different ways. For example, claim 3 defines that the cellular phones operates in a privacy enhanced mode in which a position of said cellular phone cannot be automatically detected by said automatic position sensing device. Claim 9 specifies that the override control produces a signal "that prevents said position detection module from reporting any information, in any mode of said electronic device, until manually deactivated".

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Seiple admittedly teaches a location system. This location system is intended for use in emergencies. As explained, for example, in Seiple's background, emergency location systems of the prior art have not been effective when used with GPS, since "it can take up to 15 minutes to initialize the GPS system if the almanac and ephemeris data are not available or not up-to-date". The system in Seiple then goes on to describe a system that allows GPS to be used in an emergency. According to the teaching of Seiple, for example in column 2 lines 44-47, the unit always maintains the most current GPS data.

Seiple clearly teaches that it is crucially important to maintain current GPS data. The unit cannot be initialized when first needed, because doing so "can take up to 15 minutes", see column 2 line 5.

Note also that Seiple teaches that the GPS information can be sent by the satellites every 12.5 minutes; for example see column 1 line 64. In the context of the teaching of Seiple that the GPS data can be sent periodically, Seiple also teaches power conservation features. Column 7 lines 37-40 explains that the GPS processor can be at put into sleep mode "between the times that the signals are received from the GPS satellites". This does not mean overriding the signals. Rather, Seiple teaches that the signals are received periodically and the receiver is turned off between receptions, and that the GPS data is always kept up to date.

During the interview, the Examiner stated his position that it was possible that certain GPS information could be kept up-to-date, thereby allowing the system to be quickly activated. Even assuming that this is correct, however, it does not change the teaching of Seiple that the device should be ALLOWED to determine its position, not prevented from determining its position as claimed. This is very different from claim 1

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(and certain other claims), which requires preventing the position detection module from determining its position. In fact, according to Seiple, the position module must always have some information indicative of current position; otherwise the system would have exactly the same problem as Seiple described as being undesirable. Preventing the GPS system from operating would therefore go against the express teaching of Seiple.

MPEP 2143.01, on page 2100-127, explains that a proposed modification of prior art "cannot render the prior art unsatisfactory for its intended purpose". Any modification of Seiple which prevents the position detection module from determining its position would prevent Seiple from being used as an emergency system, according to the express teaching of Seiple excerpted above. Seiple teaches that the system must always have its most current GPS fix. In order to have its most current GPS fix, it teaches away from "prevent[s] said position detection module from determining its position" as defined by claim 1, or other limitations defined by the other claims.

Claims like claim 3 are even further distinguishable; claim 3 states that the position of the cellular phone cannot be automatically detected. As described above, Seiple teaches automatically detect his position in order to follow his teaching. Claim 9 specifies that the position detection module is prevented from reporting any information in any mode of the electronic device and again Seiple has very different needs.

Therefore, it is respectfully suggested any modification of Seiple to use a manual switch to place the device into any kind of mode where GPS is not received, would go against the express teaching of Seiple that the device should always have its most current GPS fix, and would render Seiple unsuitable for its intended purpose.

Therefore, modifying Seiple to use a manual switch from Ohyama would destroy the

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inherent functionality of Seiple. This would render Seiple unsuitable for its intended and stated purpose, and hence go against the express mandate of MPEP 2143.01.

2) Seiple And Ohyama Are From Very Different Fields Of Art

MPEP 2143.01 makes it clear that the prior art must suggest the desirability of the prior art combination. Here, it is apparent that Seiple and Ohyama are from very different fields of art. Seiple teaches an emergency location device using GPS. Ohyama teaches a television system. The television system has a device 103 in Figure 17 which is labeled "sleep". However, this teaches nothing about a personal location system, a GPS system, or more generally teaches nothing about preventing a position detection module from determining its position. In fact, the sleep mode in Ohyama appears to be a more conventional type of TV sleep setting, which tells the television set to turn off after a specified period, so that the user can go to sleep or the like, while watching television; see generally column 13, lines 25-32.

Therefore, one having ordinary skill in the art would not find it apparent to combine these references, since one having ordinary skill in the art would not consider that it would be obvious to combine a reference from the television controlling art with a reference from the electronic position detection module art.

3) Even If The Hypothetical Combination Of References Were Made, The Claimed Subject Matter Still Would Not Be Obtained

Even if the references were combined, moreover, the subject matter of the claims would not be obtained. The hypothetical combination would include a Seiple type system which operated in standby mode between receptions from the GPS

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satellite; combined with an Ohyama type system which added a sleep switch telling the device that the user wanted the power supply to be interrupted "when a predetermined time comes or when a predetermined time elapses"; see Ohyama column 13 lines 30-32. Nothing in these references suggests that these references could be combined in any way to providing a manual actuation that "prevents said position detection module from determining its position but which allows other parts of said electronic device to operate". All that one would get from the hypothetical combination is a system with the basic Seiple system, with a "sleep" function of Ohyama appended to that system. However, that sleep function would only teach turning off after a specified amount of time.

Moreover, claim 1 defines the operation being carried out in the cellular phone, and nothing in the cited prior art teaches anything about such a cellular phone.

Claim 1 also defines that the manual actuating mechanism is actuated to enhance privacy, which further distinguishes over the teaching of Seiple in view of Ohyama, which teaches that the satellite detection should be turned off to save power.

Therefore, claim 1 should be allowable over this hypothetical combination, even assuming that the hypothetical combination could be made in this way.

Claim 3 should be allowable on its own merits. Claim 3 defines operating in modes, including a second privacy enhanced mode in which cellular phone functions can be used to place or receive calls but the position cannot be automatically detected by the automatic position sensing device.

First of all, nothing in the hypothetical combination of Seiple in view of Ohyama teaches anything about any cellular phone whatsoever, and certainly teaches nothing about operating a cellular phone in the first and second modes that are claimed.

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Moreover, there is no teaching or suggestion from this hypothetical combination of a second, privacy enhanced mode which allows cellular phone functions to place and receive calls but prevents "detecting .. position". In fact, Seiple in view of Ohyama teaches nothing about allowing "cellular phone functions... used to place and/or receive calls" as defined by claim 3. Therefore, claim 3 should be allowable along with claims 4-8 which depend therefrom.

The dependent claims define additional aspects. Claims 4-6 define testing the cellular phone to determine whether privacy is enhanced; and this feature is in no way taught or suggested by the cited prior art. Claim 8 specifies interfering with this position being reported, which again is not taught or suggested by the prior art, and hence is further patentable over the cited prior art. Seiple emphasizes the importance of maintaining the correct position at all times, and even further teaches away from the subject matter of claim 8.

Claim 9 defines an electronic device and an override control with a manual actuating mechanism that "prevents said position detection module from reporting said position about its position..." which should be patentable for reasons discussed above with respect to claim 1. In addition, however, claim 10 specifies that the override control "prevents said position detection module from reporting any information in any mode of said electronic device until manually deactivated". Nothing in Seiple in view of Ohyama teaches or suggests anything about this feature, and hence this feature should be additionally allowable for these reasons.

Claim 10 defines a portable telephone and telephone electronics. Nothing in Seiple in view of Ohyama teaches anything about this telephone or electronics. Claim 10 further defines the manually operated override control, which is manually operable,

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and prevents the reporting device from reporting any information of the determined position in any mode of operation. This is patentable over the cited prior art, and goes against the express teaching in Seiple that the most recent GPS fix should always be available. Therefore, claim 10 should be allowable along with claims 11-19 which depend therefrom.

Claim 12 specifies that the position detection module is allowed to determine its position but not to report it. Nothing in Seiple in view of Ohyama in any way teaches or suggests this feature.

Seiple teaches a power conservation mode, and during that power conservation mode, the GPS electronics is turned off. It certainly does not allow determination of position, and preventing of reporting of that position. Claim 12 should hence be further allowable for these reasons.

Claim 20 defines a position reporting control which prevents any reporting of information about position in any mode of the electronic device. Seiple in view of Ohyama does not teach or suggest this feature.

Therefore, claim 20 should be allowable along with claims 21-27 which depend therefrom. Each of these claims should be additionally allowable.

Claim 28 defines a cellular telephone, which, as discussed above, is not taught or suggested by Ohyama in view of Seiple. Claim 28 further defines a position reporting control which prevents reporting in any mode of operation. Again, this is not taught or suggested by Ohyama in view of Seiple, and should be allowable along with claims 29 and 30 that depend therefrom.

Claim 31 specifies a cellular phone, which should be allowable over Seiple in view of Ohyama which do not teach or suggest a cellular phone. Claim 31 also defines

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a second mode of operation which prevents any reporting of the position of the cellular phone but still allows communications. Seiple in view of Ohyama do not teach or suggest anything about this. Therefore, claim 31 should be allowable along with claims 32-35 which depend therefrom.

It is also noted that other features such as updating and testing, are completely novel over the cited prior art.

Finally, during the interview, the Examiner called applicants attention to U.S. Patent No. **5,731,785**. This is listed on the form PTO-1449 for the Examiner's convenience. This reference has been reviewed by the undersigned, and it is respectfully suggested that while this document does describe GPS, it describes nothing about the features noted above.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Therefore, for reasons stated above, it is respectfully suggested that all of the claim should be in condition for allowance. A formal notice to that effect is respectfully solicited.


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Respectfully submitted,

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